1791

No. ~~911~~

IN THE

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT

AMERICAN SALES BOOK COMPANY (A CORPORATION) AND WARREN F. BECK,
Plaintiffs in Error,

vs.

JOSEPHUS BULLIVANT, JR.,
Defendant in Error.

Petition for Re-hearing.

T. J. GEISLER,
Attorney for Plaintiffs in Error, Petitioners.

UNION PRINTING CO., 84-86 FOURTH STREET, PORTLAND, OREGON

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AMERICAN SALES BOOK COMPANY (A CORPORATION) AND WARREN F. BECK,
Plaintiffs in Error,
vs.
JOSEPHUS BULLIVANT, JR.,
Defendant in Error.

No. 971

Petition for Re-hearing.

Your petitioners, the above named plaintiffs in error, hereby petition this Court for a re-hearing of the writ of error in the above entitled cause, for the following reasons:

It appears to your petitioners from the opinion of this Court that their argument has been misunderstood, and by reason thereof, the error of law, specified in the

12th Assignment of Error against the judgment of the Court below, has been overlooked.

The opinion of this Court states the following propositions of law:

a. That the thing patented must combine, 1 Novelty; 2. Utility; 3. Invention, and it is void if it lacks either; whether it does is a question of fact.

b. That extensive use is not conclusive on the question of patentable novelty.

c. That the plaintiffs in error have argued this case upon the theory that it is the duty of the Court to review all the *findings of fact* found by the Court below, and determine whether there is any *sufficient evidence* to support such findings. Such, however, is not the law.

d. That the only question on the writ of error before this Court is whether there is any error in the *judgment* granted by the Court upon the *facts found.*

The plaintifffs in error did not question the rules of law stated in the foregoing propositions. But proposition *C* does not state the position of your petitioners before this Court.

The real position of the plaintiffs in error was, that upon the *ultimate* facts (to be distinguished from *mere recitals of evidence*) found by the Court below, its conclusion of law and judgment cannot be supported. This was the main ground for suing out the writ of

error in this case, and is the reason given in the 12th Assignment of Error, which reads:

"12. Error of the Court in giving *judgment* in favor of the defendant in this case on the *facts found* by the Court." (Record P. 44.)

It is also of record in the Bill of Exceptions (Record P. 39) that plaintiffs in the Court belowduly excepted to the conclusion of law and judgment of the Circuit Court for the reason that the *facts found are wholly insufficient to support said judgment.*

Under said 12th Assignment of Error, your petitioners desire to submit to your honors, as a question of law, that the judgment of the Court below cannot be upheld for the following reasons:

1. That the mere fact found by the Court below in its 12th finding, that the patented invention possessed no *superior* degree of utility over other contrivances for a like purpose, is not sufficient to sustain its conclusion of law and judgment, that the patent is void for lack of novelty in the thing invented. The true rule of law is, that while the thing patented must possess novelty and utility, and must have required invention, yet the degree of either is immaterial.

2. That though the Court below may not have applied such erroneous rule of law, it, nevertheless, is evident that *its judgment is not supported by any finding of fact on the material issues in the case. There was no finding of the Circuit Court that the Beck book was devoid of patentable novelty.* Un-

doubtedly, it is sufficient to defeat the Beck patent, if the thing patented absolutely lacks either novelty, or utility, or invention; and the ultimate finding of fact on either issue by the Court below is not reviewable. But the letters patent in question were *prima facie* proof of the existence of all three requirements; and our petitioners submit *that whatever the sufficiency of defendant's evidence to prove that the Beck improvement was not a patentable novelty, the issue required a specific finding; and such finding cannot be supplied by assuming what the trial court may have intended.*

From an inspection of the Findings (Record P. 29) it appears that the infringement of Beck's patent is admitted. The question at issue was whether the patent was valid. Defendant contended that it was not, because of the prior state of the art. To substantiate this contention defendant introduced evidence of certain devices which he claimed anticipated Beck's idea. The nature of such evidence is stated in the Circuit Court's findings of fact Nos. 7 to 10 inclusive. Such findings are mere statements of the *preliminary* facts upon which the Circuit Court was then to find the *ultimate* fact—whether the Beck improvement did or did not possess patentable novelty. But it is apparent that the Circuit Court entirely omitted to find on such issue either way.

Following the findings stating the evidence on the issue involved is the 11th. This reads:

"11. That the *defendant relied* on the stipulation

as to facts herein and also as illustrated by defendant's exhibits A, B and C, and also upon the use of thumb-holes in indexes for books, *as proving that* the said invention lacks novelty, and is a mere mechanical change of said existing devices."

Manifestly, this finding cannot be construed as an ultimate finding on the issue of patentable novelty. It is a mere statement of *what the defendant relied on*, and of what the defendant *claimed* as the effect of his proof *without determining what such effect really is.*

The 12th finding on utility has already been considered;

Immediately following such 12th finding, the Circuit Court announced as its *conclusion of law* and judgment in the premises that the patent to Beck was void for lack of novelty.

That the conclusion of law is distinct from the findings of fact, and cannot be considered in aid of the latter need not be argued.

Special findings, as in the case before your honors, must be considered the same as a special verdict.

> Sec. 700 Rev. Stat. *Supervisors* vs. *Kennicott*, 103 U. S. 554,556.

In order to support a judgment, the special verdict must pass on all the material issues made by

the pleadings. The *ultimate fact* must be found. A detailed account of the *evidence* tending to prove the ultimate fact will not answer, remarked Ch. J. Marshall, "although in the opinion of the Court there was sufficient *evidence* in the special verdict from which the jury *might* have found the fact."

Barnes vs. *Williams, 11 Wheat. 415.*

When the judgment is not sustained by the special verdict it must be reversed and a new trial ordered.

Hodges vs. *Easton, 106 U. S., 408.*

In the State of Oregon, where this case was tried, it has been repeatedly held that a party is entitled as a matter of right to a finding on every material issue made by the pleadings; and the absence of such finding is a reversible error.

Moody vs. *Richards, 29, Or. 282.*

Daley vs. *Larsen, Ib. 535.*

Jameson vs. *Coldwell, 25 Or. 199.*

Fink vs. *Canyon Road Co., 5 Or. 301.*

Pengra vs. *Wheeler, 24 Or. 532.*

Courts cannot upon a special verdict infer facts not actually found.

Bank of Alexandria vs. *Swann, 2 Fed. Cas. 615.*

Nothing is to be intended in aid of a special verdict.

A special verdict must be certain, so as to stand as a final decision of the special matters with which it deals.

If it be ambiguous, or uncertain, or doubtful which way the Court intended to find, a new trial must be awarded.

Where a special verdict fails to determine all the issues, *the ignored issues must be regarded as not sustained by the party on whom rests the burden of proof.*

Vol. 28 Am. & Eng. Enc. Law, pp. 380,388, and cases there collated.

Since the judgment here in question is not sustained by the special findings, it should be reversed, and a new trial ordered.

Your petitioners, therefore, pray that the Court may reconsider its conclusions in this cause, and that the plaintiffs in error be awarded such relief as they are entitled to.

Respectfully submitted,

AMERICAN SALES BOOK COMPANY
and WARREN F. BECK,
Plaintiffs in Error.

By T. J. GEISLER,
Attorney for Petitioners.

UNITED STATES OF AMERICA,
District of Oregon, } ss.

I, T. J. Geisler, do hereby certify that I am an attorney and counselor of this Court; That I have personally prepared and examined the foregoing petition for re-hearing; and that the same is well founded in my judgment, and that it is not interposed for delay.

T. J. Geisler

Atty. and Counsel for Petitioners.